

REMARKS/ARGUMENTS

These remarks are submitted in response to the final Office Action dated March 22, 2005 (Office Action). This response is filed after the 3-month shortened statutory period, and as such, a retroactive extension of time is herein requested. The Examiner is authorized to charge the appropriate extension fee to Deposit Account 50-0951. The response includes newly presented claims and is being filed as a Request for Continued Examination to insure consideration of the claims and evidence of diligence following conception, as well as to expedite prosecution of this case.

In paragraphs 3-4 of the Office Action, claims 1-12 were rejected under 35 U.S.C. § 102(e) as being anticipated by Published Application No. US 2002/0101858 to Stuart, *et al.* (hereinafter Stuart). The Office Action stated that the previously-submitted Applicants' Declarations under 37 C.F.R. § 1.131 (the Declarations) and factual evidence relating thereto were not entered into the record and arguments based upon the same were not considered.

In response, Applicants re-assert the previously submitted Declarations supporting the removal of Stuart as a reference. The Declarations are accompanied by a copy of the Applicants' Confidential Invention Disclosure No. BOC8-2000-0003 (hereinafter Disclosure) entitled "Multi-tier ASP / Software Delivery for Wireless Devices." The Disclosure demonstrates proof of conception for the claimed subject matter of the Applicants' invention at least as early as January 18, 2000, which predates the January 31, 2001, effective date of Stuart. In addition to the previously submitted Declarations, Applicants herewith submit evidence of activity on specific dates that show Applicants' continued diligence from prior to the effective state of Stuart. The evidence addresses the issues raised in paragraphs 1 and 2 of the Office Action.

The Disclosure was the completion of an International Business Machines Corporation (IBM) confidential disclosure form, which is a standardized document

utilized by IBM and submitted by the inventors upon conception of an invention. IBM has established internal procedures governing the use of such IBM disclosures from its inventors. The procedures preclude substantive modifications to a disclosure subsequent to the disclosure's submission to an IBM Attorney/Patent Professional. Instead, any changes and/or additions are appended as an attachment to an IBM confidential disclosure form together with the date the attachment was added. No such attachment accompanies the instant Disclosure, thus demonstrating that the Disclosure has not been substantively amended since its submission on January 18, 2000.

The present application, including each claim, was prepared based upon Applicants' Disclosure. Moreover, according to IBM's established procedures governing the use of such disclosures, the inventors reviewed the application prior to its submission to the U.S. Patent and Trademark Office so as to insure that the claims and material contained therein were fully supported by the Disclosure. Each of the claims in the application are fully supported in the Disclosure. (See particularly page 3, beginning with the third paragraph, through page 4, including the suggested claim in the fourth paragraph at page 4.)

Applicants further exercised due diligence from prior to the effective date of Stuart to August 6, 2001, the date the present application was filed. With respect to Applicants' diligence it is to be noted that, as set forth in the Declarations, once an IBM invention disclosure form is completed, the disclosure is reviewed by an invention review board within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon reaching a decision to prepare an application, outside counsel is selected to prepare the application, and instructions in this regard, together with the IBM invention disclosure form, are conveyed to the outside counsel. Outside counsel prepares a draft of the Application that is iteratively reviewed by each inventor until such time that the inventors are satisfied that the Application sufficiently details the inventive concepts detailed in the Disclosure.

As to the period between January 18, 2000 and August 6, 2001, this was a time period in which outside counsel spent drafting co-pending Application No. 09/803,256 [outside counsel docket no. 6169-181], filed March 9, 2001, and subsequently the present application upon further direction from the client to "split the case" and file a separate application. Further to the filing date of co-pending Application No. 09/803,256, outside counsel iteratively reviewed and revised the drafted application with the inventors until it was finalized in its submitted form. This activity (*reviewing a patent application*) during the period noted above is believed to clearly satisfy the legal requirements for a showing of diligence under MPEP 715.07(a). As proof of diligence-evidencing activities, Applicants refer the Examiner to the following documents contained in Composite Exhibit "A," attached hereto:

1. July 26, 2000 correspondence from IBM to outside counsel instructing the preparation and filing of co-pending Application No. 09/803,256;
2. E-mail from Applicants' support staff regarding scheduled meeting with outside counsel for January 19, 2001 dated January 3, 2001;
3. Correspondence from outside counsel to lead inventor faxed January 23, 2001 forwarding a draft of co-pending Application No. 09/803,256;
4. February 20, 2001 fax transmittal page indicating correspondence between the outside counsel and the lead inventor (forwarding a revised draft with formal documents for signing);
5. February 28, 2001 correspondence from in-house counsel at IBM responding to outside counsel's e-mail dated February 19, 2001 and supporting decision to split the co-pending Application No. 09/803,256 into two filings;

6. July 26, 2001 letter and fax transmission sheet to the inventors submitting draft application of the instant application for review;
7. July 27, 2001 letter and fax transmission sheet to the inventors submitting the final application and formal documents for their execution;

In the present case, IBM sent official authorization to outside counsel to prepare co-pending Application No. 09/803,256 on July 25, 2000 (*See* item no. 1 above) and subsequently sent official authorization to outside counsel to prepare the instant application on February 28, 2001 (*See* item no. 5 above). Outside counsel prepares cases on a "first come, first served" basis, where applications associated with bar dates are granted priority within the work queue. This is a common practice in the industry followed by a significant portion of patent firms and believed to be reasonable by the majority of large entities with substantial patent portfolios, such as IBM. As proof that the co-pending Application No. 09/803,256 and the present application were included within the work queue and receiving attention therein, Applicants have provided pages from their Firm Docket regarding the two applications [outside counsel docket numbers 6169-181 and 6169-241, respectively], dated October 26, 2000, November 26, 2000, December 25, 2000, January 8, 2001, January 26, 2001, February 26, 2001, March 26, 2001, April 1, 2001, May 1, 2001, June 1, 2001, and the subsequent electronic docket sheet titled "Actions Due" created March 6, 2001 (redacted to insure confidentiality of other Firm clients and attached hereto as Composite Exhibit "B").

Applicants believe that the evidence provided clearly establishes reasonable diligence from a time prior to the effective date of Stuart to the filing date of the present Application and that diligence was exercised in constructively reducing the invention to practice between the date of the Disclosure, above, until the filing date of the present Patent Application.

Accordingly, Applicants respectfully request that Stuart be withdrawn as a reference.. Withdrawal of Stuart as a reference should place all 18 claims in the present case (as amended) in condition for allowance, which action is respectfully requested.

CONCLUSION

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned (Direct Line 561-671-3616) if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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